

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID B. REES

Appeal No. 2000-2251
Application No. 08/902,206

ON BRIEF

Before BARRETT, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 2, 9-11, 13-15, 20, and 21. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The appellant's invention changes the function of an integrated circuit ("IC"). According to the appellant, several methods for modifying the function of an IC exist. (Spec. at 1.) For example, circuitry in an IC may be isolated by burning in the manner that bad memory cells are isolated in a memory circuit. (*Id.*)

In contrast, the appellant selects the functionality of an IC by bonding out (i.e., grounding) or not bonding out particular bonding pads. The bonding pads are connected to a decoder located on the IC. Based on which bonding pads have been bonded out, the decoder determines which path of a predetermined number of paths is to be chosen to provide the selected function. More specifically, four bonding pads are provided, and sixteen combinations are possible from the four pads. The decoder determines which of the sixteen options has been selected and feeds the selection to a circuit that generates control signals responsive thereto. The control signals are fed to logic circuits that control functions of sub-circuits within the various portions of the IC. By determining the function of the sub-circuits, the overall functionality of the IC is dictated. (*Id.* at 3.)

A further understanding of the invention can be achieved by reading the following claim:

14. An apparatus for controlling functionality in an integrated circuit by bond optioning including:

bond option means for providing a plurality of signals; and

decoder means for receiving said signals and providing a number of outputs each having a state depending on which of said bond option means is bonded out.

Claims 2, 9-11, 13-15, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,161,124 ("Love") in view of M. Morris Mano, *Computer Engineering: Hardware Design* (1998) ("Mano").

OPINION

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the main point of contention therebetween. Admitting that "Love does not teach the . . . a decoding circuit as claimed," (Examiner's Answer at 3), the examiner concludes, "it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have replaced the non-decoding logic circuitry of Love with decoder circuitry, as taught by Mano in order to allow more programming options per I/O pin, as a matter of design choice." (*Id.* at 4.) The appellant argues, "there is no suggestion or motivation to combine the references. . . ." (Appeal Br. at 23.)

"[T]o establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "[T]he factual inquiry whether to combine

references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008(Fed. Cir. 2001). “This factual question . . . [cannot] be resolved on subjective belief and unknown authority.” *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). “It must be based on objective evidence of record.” *Id.* at 1343, 61 USPQ2d at 1434.

Here, the examiner fails to show objective evidence of the desirability of replacing Love’s non-decoding logic circuitry with decoder circuitry. His broad, conclusory statement that such a replacement would have been “a matter of design choice,” (Examiner’s Answer at 4), is not evidence. Therefore, we reverse the rejection of claims 2, 9-11, 13-15, 20, and 21.

CONCLUSION

In summary, the rejection of claims 2, 9-11, 13-15, 20, and 21 under § 103(a) is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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APJ BARRETT

After signing, forward to Team 3 for proofing.

After proofing, return to APJ Barry for disk.

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Prepared By: APJ BARRY

DRAFT SUBMITTED: 03 Jun 03

FINAL TYPED:

Team 3:

I typed all of this opinion.

Please proofread spelling, cites, and quotes. Mark your proposed changes on the opinion, but **do NOT change matters of form or style. I will include the diskette with the signed copy so that you can make all changes before mailing.**

For any additional reference provided, please prepare PTO 892 and include copy of references

Thanks, Judge Barry